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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,933	11/21/2001	John Zachariassen	3199 0003	9533

27886 7590 11/12/2004  
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EXAMINER

AUGUSTIN, EVENS J

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/988,933

Applicant(s)

ZACHARIASSEN ET AL.

Examiner

Evans Augustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/21/2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 21 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Status of Claims***

1. Claims 1-53 have been examined.

***Priority***

2. Acknowledgment is made of applicant's claim for domestic priority under 35 U.S.C 119(e) of a previously filed provisional application. The certified copy has been filed in parent application No. 60/252,360, filed on 11/21/00.

***Claim Objections***

3. Claim 30 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim(s) in independent form. Claim 30 did not restrict the limitations of a previous claim. Claim 30 is referring to a succeeding claim 31.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Claim 30 recites the limitation "the multimedia language" in the 2<sup>nd</sup> line of the claim.

There is insufficient antecedent basis for this limitation in the claim. There is no earlier reference in the claim to the multimedia language.

7. Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 47 recites the limitation "the subject matter of intellectual property" in the 2<sup>nd</sup> line of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 6-9, 17-37, 39-47 and 49-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Shavit et al. (U.S 4,799,156).

As per claims 1-4 and 6-9, Shavit et al. discloses an interactive system for transmitting goods comprising of:

- A distribution channel (column 15, lines 2-3)
- Communication channel for business transactions (column 2, lines 14-19)
- Communication network and channel comprising of central processor unit, input/output devices and databases (column 5, lines 39-50, Figure 1)
- Database for creating user profiles (column 9, lines 53-54)

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- Electronically capable of receiving and transmitting delivery instructions (Invoices) from buyers (column 11 lines 52-56)
- Capability of receiving confirmation of transaction orders (column 14 lines 3-4)
- Capability of sending delivery notices and confirmation to users (column 14 lines 17-19).
- Users engaging in negotiations via invoices or master agreements (column 13 lines 35, 51).
- Information that can be received from other sources other than the buyer (column 7, lines 6-14).
- Users are required to be identified by means of a user ID and a password recognized by the system (column 10 lines 2-5).

As per claims 15-28, Shavit et al. discloses an interactive system for transmitting goods, in which:

- Virtual or computer-to-computer authentication takes via electronic means (column 9 lines 58-65).
- The system uses an encryption algorithm method for encrypting user ID and Password (column 10, lines 2-4).
- The system consults the user's security profile as well as service provider or intermediary's profile (column 10 lines 36-39).
- The system creates a profile for every user and subscriber that is maintained in a database (column 9 lines 53-54).

- The user profile contains information for authentication and automatically checks the limitations within the user profile to allow access to a community of buyers and relevant services (column 10 lines 21-34).
- The system allows the user access, provided that the user will pay for a particular service (column 10 lines 41-44).
- The system consults the user's security profile as well as the profile of service providers or institutions to assure that selected functions are provided to the user (column 10 lines 36-39).
- The system allows the user to select members of the supply chain, i.e. a distributor or freight company (column 10 lines 15-20).
- Users have contractual terms of delivery (column 38, line 55).
- Advisories about any amendment to the order or change in the delivery schedule are delivered to the customer and other desired parties (column 16, lines 26-29)
- The system can reject an order, propose substitutes, confirm availability or defer the order confirmation (column 14, lines 4-7).

As per claims 29-31, Shavit et al. discloses an interactive system for transmitting goods that uses graphic user interface comprising of multimedia languages such as signs, nested menus and shortcuts to aid beginning users (column 10, lines 45-60). Since the system maintains a profile for each user (column 9, lines 53-56), the profile may be customized to add interface references for each user. The profile may also have user's cultural/geographical information.

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As per claims 32-36, Shavit et al. discloses an interactive system for transmitting goods that:

- Keeps historical data on every transaction carried out (column 11, line 22-24).
- Users can enter negotiations via a purchase orders (column 25, lines 51-59, Figure 14-item 336).
- The system processes purchase orders and provides confirmation as well as errors (column 25, lines 63-66).
- The system can confirm available orders, propose substitutes for unavailable items and indicate when items will become available (column 26, lines 1-4).
- The user can select a shipping and receiving function, which provides delivery advisories between buyer and seller (column 26, lines 34-37, Figure 2 – item 350).
- The buyer can select a function in which payments can be made, based on the agreement between the buyer and the seller (column 26, lines 37-44, Figure 2-item 344).
- Payments can be made through a financial institution or supplier (column 8, line 43).

As per claims 37 and 43, Shavit et al. discloses an interactive system for transmitting goods that can handle various methods of payments such as promise to pay, collection of funds, reports, etc. (column 8, line 36-37).

As per claims 39 and 46, Shavit et al. discloses an interactive system for transmitting goods, in which a buyer can use the distribution channel to pay an invoice by promising or making a commitment to pay for the order to a trust account on behalf of the distributor (column 28, line 34-39).

As per claims 40-42, Shavit et al. discloses an interactive system for transmitting goods, in which:

- The system provides balances and statement information to ensure that funds are received in their entirety (column 9, line 37-40).
- The system provides for partial payments by allowing advances to pay for invoices (column 8, line 66-67).
- The system has the capability to carry payments instructions to the user's bank (column 8, lines 57-58).

As per claims 44-45 and 47, Shavit et al. discloses an interactive system for transmitting goods, that:

- Allows distributors to provide their customers with a more convenient and efficient way to purchase goods (column 6, lines 19-21).
- Subscribers can provide proprietary information services (column 7, lines 19-22).

As per claims 49-52, Shavit et al. discloses an interactive system for transmitting goods, in which:

- The system creates documents (column 14, lines 24-27), and maintains documents such as subscriber personnel database records (column 9, line 53-55).
- Provides information between various members of an industry (column 2, lines 9-14).
- The system receives instructions to processes purchase orders and provides confirmation as well as errors (column 25, lines 63-66, Figure 14- item 336).



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- The system can confirm available orders, propose substitutes for unavailable items and indicate when items will become available (column 26, lines 1-4).
- The user can select a shipping and receiving function, which provides delivery advisories between buyer and seller (column 26, lines 34-37, Figure 2 – item 350).
- The buyer can select a function in which payments can be made, based on the agreement between the buyer and the seller (column 26, lines 37-44, Figure 2-item 344).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5, 38 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. in view of Reeder (U.S 5852812).

As per claims 5, 38 and 53, Shavit et al. discloses an interactive system for transmitting goods comprising:

- A distribution channel (column 15, lines 2-3).
- Communication channel for business transactions (column 2, lines 14-19).
- Communication network and channel comprising of central processor unit, input/output devices and databases (column 5, lines 39-50, Figure 1).
- Database for creating user profiles (column 9, lines 53-54).

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- Electronically capable of receiving and transmitting delivery instructions (Invoices) from buyers (column 11 lines 52-56).
- Capable of receiving confirmation of transaction orders (column 14 lines 3-4).

Shavit et al. did not explicitly describe a system in which the transaction terms comprise of any applicable exchange rates and taxes. However, Reeder describes a billing system for on-line computer networks, which comprises of a currency converter receiving currency exchange rates for the currencies and charge data from the billing database; and a credit company computer receiving charge data from the billing database and the currency converter so as to charge network customers in a local currency. (column 3, lines 16-25). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that would process invoices, with any applicable foreign exchange currency rates and taxes. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement Reeder's on-line billing system, in order to do business with international customers. Doing business internationally would increase profitability and accelerate the growth of the business.

13. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. in view of Ginter et al. (U.S 6185683).

As per claims 10-14, Shavit et al. fails to describe a system in which the authentication is accomplished via biometric samples such as finger print, hand scan, iris scan, retinal scans, face recognition and voice recognition. Shavit et al. also fails to describe a system that uses Smart Card authentication techniques. However, Ginter et al. describes a system in which documents and other items can be delivered electronically from sender to recipient, using biometric

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authentication such as palm print scan, signature scan, voice scan, retina scan, iris scan, biometric fingerprint and/or handprint scan, and/or face profile (column 8, lines 15-22). Ginter et al. also describes a delivery system that is also compatible with Smart Cards (column 16, line 54). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that would use biometric/smart card authentication techniques. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement Ginter's et al. delivery system in order provides significant efficiency and cost savings benefits to users in addition to providing an extremely high degree of confidence and trustiness. It would have also been obvious for one of ordinary skill in the art at the time of the applicant's invention to provide a highly secure system in order to obtain significant efficiency and cost savings benefits.

14. Claims 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. (U.S 6185683) in view of Ginter et al. (U.S 5892900 ).

15. As per claims 47-48, Shavit et al. did not specifically mentioned Intellectual Property document, such as copyright, patent, trade secret and know-how, semiconductor chip design and trademark to be distributed in his system. However, Ginter et al. describes an electronic commerce system that secures the distribution of intellectual property documents (column 43, line 36). These distributed documents include, but not limited to copyrights (column 47, line 35). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system in which Intellectual Property document can be distributed. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement Ginter's et al. system in order to provide secure distribution

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of Intellectual Property documents and to protect the rights of the creators of these documents (column 4, lines 14-29).

*Conclusion*

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Barnes et al. (US 5970475)

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 703-305-0267. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammel can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

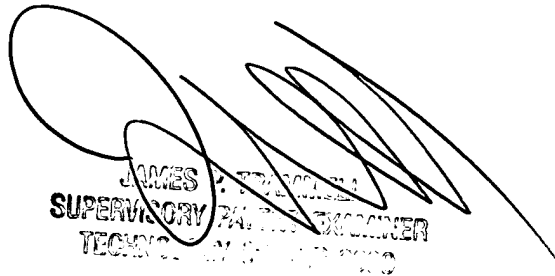
Or faxed to:

(703) 305 – 5532 (for formal communications intended for entry and after-final communications), or (703)746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Evens J. Augustin  
October 28, 2004  
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